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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,120	03/17/2000	Daphne Preuss	ARCD:P-01912US7	5601

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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/531,120

Applicant(s)
Preuss

Examiner
Arun Chakrabarti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 20, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 132, 133, and 141-144 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 141-144 is/are allowed.
- 6) ☒ Claim(s) 132 is/are rejected.
- 7) ☒ Claim(s) 133 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☒ Other: **Detailed Action**

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DETAILED ACTION

Specification

1. Claims 128-131, 134-140, and 145-146 have been cancelled. Claims 132, and 141-143 have been amended. Finality of the last office action is hereby withdrawn.

Claim Rejections - 35 USC § 112

2. *The following is a quotation of the first paragraph of 35 U.S.C. 112:*

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 132 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 132 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for nucleic acid constructs and methods using the dicotyledonous *Arabidopsis thaliana* centromere and the starting plant cell *Arabidopsis thaliana*, does not reasonably provide enablement for making any transgenic plant with *Arabidopsis thaliana* centromere. The specification does not enable any person skilled in the art to which it pertains, or

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with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The Court in *re Wands*, 8 USPQ2d 1400 (CA FC 1988) stated with regard to enablement that

“Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized by the board in *Ex parte Forman*. They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.”

Here, the claim is broadly drawn to any plant and method of preparing any plant comprising any cell transformed with *Arabidopsis thaliana* centromere. However, the specification does not provide guidance commensurate in scope with this claim. The specification provides minimal guidance regarding any plant and method of preparing any plant comprising any cell transformed with *Arabidopsis thaliana* centromere. There is only one working example of *Arabidopsis* centromere mapping and characterization (Example 6). It is highly unpredictable whether or what other treatments would function in the context of preparing transgenic plants as Ebinuma et al (*Proc. Natl. Acad. Sci., USA* (1997 March), Vol. 94), pages 2117-2121) teaches, “(i) the selective agents have negative effects on proliferation and differentiation of plant cells, (ii) there is uncertainty regarding the environmental impact of many selectable marker genes, (iii) it is

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difficult to perform recurrent transformation using the same selectable marker to pyramid desirable genes (Abstract)". It is therefore highly unpredictable whether other treatment strategies can be identified which meets this specific criteria regarding the successful introduction of economically valuable genes like centromeres into crop plants. Further, as indicated by Kriz et al.(U.S. Patent 6,307,123 B1) (October 23, 2001) identification of difficulties associated with plants possessing multiple transgenic copies including gene slicing, recombination and unpredictable inheritance (Page 63, lines 7-16), trial and error experiments must be carried out . This trial and error requirement is borne out because effects of random insertion of DNA into plant genome cannot be readily deduced, even where the genetic mapping and metabolic pathways are known. Further, each transfer of gene has unpredictable effects on metabolic function, and no general method for a priori selection of transfer of gene is presented. It would require a large amount of experimentation, potentially including the synthesis of millions of genes, in order to identify additional transgenic plants with the claimed functionality. Given the Wand's factors opposing the full scope of enablement including the limited teaching in the specification, the absence of sufficient working example, the teaching of unpredictability in the prior art, the unpredictability of the art, the breadth of the claim, and the large amount of experimentation needed, with only the skill level in the art being neutral towards enablement, it is concluded that undue experimentation is necessary to make and use the invention as broadly claimed.

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35 U.S.C. 112, Written Description Rejection

4. Claim 132 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification discloses SEQ ID NO: 1-21 which corresponds to the cDNA/genomic DNA encoding the Arabidopsis thaliana centromere sequences. Claim 132 is directed to encompass all plant gene sequences, sequences that hybridize to all plant gene sequences corresponding sequences from other species, mutated sequences, allelic variants, splice variants, sequences that have a recited degree of identity (similarity, homology), and so forth. None of these sequences meet the written description provision of 35 USC 112, first paragraph. The specification provides insufficient written description to support the genus encompassed by the claim.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the 'written description' inquiry, *whatever is now claimed*." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

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With the exception of SEQ ID NO: 1-21, the skilled artisan cannot envision the detailed chemical structure of the encompassed polynucleotides and/or proteins, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The nucleic acid itself is required. See Fiers v. Revel, 25 USPQ2d 1601, 1606 (CAFC 1993) and Amgen Inc. V. Chugai Pharmaceutical Co. Ltd., 18 USPQ2d 1016. In Fiddes v. Baird, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence.

Finally, University of California v. Eli Lilly and Co., 43 USPQ2d 1398, 1404, 1405 held that:

...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.* , 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli* , 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious,"

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and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood* , 107 F.3d at 1572, 41 USPQ2d at 1966.

An adequate written description of a DNA, such as the cDNA of the recombinant plasmids and microorganisms of the '525 patent, "requires a precise definition, such as by structure, formula, chemical name, or physical properties," not a mere wish or plan for obtaining the claimed chemical invention. *Fiers v. Revel* , 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993). Accordingly, "an adequate written description of a DNA requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it; what is required is a description of the DNA itself." *Id.* at 1170, 25 USPQ2d at 1606.

The name cDNA is not itself a written description of that DNA; it conveys no distinguishing information concerning its identity. While the example provides a process for obtaining human insulin-encoding cDNA, there is no further information in the patent pertaining to that cDNA's relevant structural or physical characteristics; in other words, it thus does not describe human insulin cDNA. Describing a method of preparing a cDNA or even describing the protein that the cDNA encodes, as the example does, does not necessarily describe the cDNA itself. No sequence information indicating which

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nucleotides constitute human cDNA appears in the patent, as appears for rat cDNA in Example 5 of the patent. Accordingly, the specification does not provide a written description of the invention of claim 5.

Therefore, only SEQ ID NO: 1-21 and only starting plant *Arabidopsis thaliana* but not the full breadth of the claim (or none of the sequences encompassed by the claim) meets the written description provision of 35 USC 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC 112 is severable from its enablement provision. (See page 1115.).

Double Patenting

5. Claim 132 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,156,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 6 of U.S. Patent No. 6,156,953 basically and fundamentally teaches the instant method claim of preparing a transgenic plant cell by contacting a starting plant cell with recombinant DNA construct comprising an *Arabidopsis thaliana* centromere.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

Allowable Subject Matter

7. Claim 133 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 141-144 are allowed.

Response to Amendment

8. In response to amendment, claim 133 is objected to and claims 141-144 are allowed. However, 112 (written description and enablement) rejections against claim 132 have been maintained. A new obviousness type double patenting rejection has been included.

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Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119. The fax phone number for this Group is (703) 746-4979. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group analyst Chantae Dessau whose telephone number is (703) 605-1237.

Arun Chakrabarti,

Patent Examiner,

July 1, 2003


ARUN K. CHAKRABARTI
PATENT EXAMINER